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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,884	01/23/2004	Rami Caspi	2003P13120US	6012
7590 Siemens Corporation Attn: Elsa Keller, Legal Administrator Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830			EXAMINER GAUTHIER, GERALD	
			ART UNIT 2614	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/763,884

**Applicant(s)**

CASPI ET AL.

**Examiner**

Gerald Gauthier

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 1, 2006 has been entered.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim(s) 17** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "A article of manufacture" is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception (e.g., because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result).

**Claim(s) 1-14 and 18** are rejected under 35 U.S.C. 101 because the article of manufacture is running the method claims.

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claim(s) 1, 4-6, 10-15, 17 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk (US 2004/0151284 A1) in view of Ward et al. (US 2005/0136896 A1).

Regarding **claim(s) 1**, Adamczyk discloses a method (FIG. 2 and paragraph 0002), comprising:

receiving a first voice mail message, said first voice mail message being associated with a recipient (FIG. 2 and paragraph 0066) [The VMS 306, 316 receives a message from a sending subscriber for a recipient subscriber];

converting said first voice mail message to a first instant message (FIG. 2 and paragraph 0069) [The voice mail message is encoded into a text message suitable for transmission at an instant message platform]; and

determining an instant message address associated with said recipient (FIG. 2 and paragraph 0067) [The VMS 306 retrieves a corresponding address for an instant message user from an associated database].

Adamczyk discloses a voice mail message converted into an instant message but fails to disclose sending the first instant message and the first voice mail message to the address.

However, Ward teaches sending said first instant message and said first voice mail message to an address (paragraph 0032).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk using the teaching of sending the voice message with an instant message as taught by Ward.

This modification of the invention enables the system to send said first instant message and said first voice mail message to said address so that the user would

retrieve the voice message and the text message and compare them for a better translation.

Regarding **claim(s) 4**, Adamczyk discloses a method, further comprising:  
receiving a command from said recipient regarding said first voice mail message (FIG. 4 and paragraph 0075).

Regarding **claim(s) 5**, Adamczyk discloses a method, further comprising:  
receiving a command from said recipient regarding a second voice mail message (FIG. 4 and paragraph 0075).

Regarding **claim(s) 6**, Adamczyk discloses a method, further comprising:  
sending data indicative of a calling telephone number associated with said first voice mail message (FIG. 4 and paragraph 0077).

Regarding **claim(s) 10**, Adamczyk discloses a method, further comprising:  
receiving a second instant message, said second instant message being indicative of a request for information regarding at least one voice mail message associated with said recipient (FIG. 4 and paragraph 0077).

Regarding **claim(s) 11**, Adamczyk discloses a method, further comprising:  
receiving a second instant message, said second instant message including a text message (FIG. 4 and paragraph 0078).

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Regarding **claim(s) 12**, Adamczyk discloses a method, further comprising:  
converting said second instant message into a second voice mail message (FIG. 4 and paragraph 0078).

Regarding **claim(s) 13**, Adamczyk discloses a method, further comprising:  
providing said second voice mail message to a party associated with said first voice mail message (FIG. 4 and paragraph 0078).

Regarding **claim(s) 14**, Adamczyk discloses a method, wherein said second instant message includes data indicative of a party and further comprising providing said second voice mail message to said party (FIG. 4 and paragraphs 0077-0078).

Regarding **claim(s) 17**, Adamczyk discloses an article of manufacture (FIG. 2) comprising:

a computer readable medium having stored thereon instructions which, when executed by a processor (FIG. 2 and paragraph 0002), cause said processor to:

receive a first voice mail message, said first voice mail message being associated with a recipient of said first voicemail message (FIG. 2 and paragraph 0066)  
[The VMS 306, 316 receives a message from a sending subscriber for a recipient subscriber];

convert said first voice mail message to an instant message; determine an instant message address associated with said recipient (FIG. 2 and paragraph 0069)

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[The voice mail message is encoded into a text message suitable for transmission at an instant message platform].

Adamczyk discloses a voice mail message converted into an instant message but fails to disclose sending the first instant message and the first voice mail message to the address.

However, Ward teaches send said instant message and said first voice mail to said Internet message address of said recipient (paragraph 0032).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk using the teaching of sending the voice message with an instant message as taught by Ward.

This modification of the invention enables the system to send said first instant message and said first voice mail message to said address so that the user would retrieve the voice message and the text message and compare them for a better translation.

Regarding **claim(s) 18**, Adamczyk discloses an apparatus (FIG. 2), comprising:

a processor (FIG. 2);

a communication port coupled to said processor and adapted to communicate with at least one device (FIG. 2); and

a storage device coupled to said processor and storing instructions (FIG. 2 and paragraph 0002) adapted to be executed by said processor to:



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receive a first voice mail message, said first voice mail message being associated with a recipient of said first voicemail message (FIG. 2 and paragraph 0066) [The VMS 306, 316 receives a message from a sending subscriber for a recipient subscriber];

convert said first voice mail message to an Instant message (FIG. 2 and paragraph 0069) [The voice mail message is encoded into a text message suitable for transmission at an instant message platform]; and

determine an instant message address associated with said recipient (FIG. 2 and paragraph 0069) [The voice mail message is encoded into a text message suitable for transmission at an instant message platform].

Adamczyk discloses a voice mail message converted into an instant message but fails to disclose sending the first instant message and the first voice mail message to the address.

However, Ward teaches send said instant message and said first voice mail to said instant message address of said recipient (paragraph 0032).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk using the teaching of sending the voice message with an instant message as taught by Ward.

This modification of the invention enables the system to send said first instant message and said first voice mail message to said address so that the user would retrieve the voice message and the text message and compare them for a better translation..

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7. **Claim(s) 2 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk in view of Ward as applied to **claim(s) 1** above, and further in view of Hanson et al. (US 6,697,474 B1).

Regarding **claim(s) 2**, Adamczyk in combination with Ward as applied to **claim(s) 1** above differs from **claim(s) 2**, in that it fails to disclose determining if said recipient is available to receive an instant message.

However, Hanson, in the same field of endeavor, teaches a method, further comprising: determining if said recipient is available to receive an instant message (FIGS. 7-9 and column 8, lines 57-63) [The ACP 125 queries the database to determine if the user is currently on line].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk in combination with Bijl using the automated call processor as taught by Hanson.

This modification of the invention enables the system to determine if said recipient is available to receive an instant message so that the user would receive a telephone call via its instant messaging client as a virtual second telephone line (Hanson: column 2, lines 1-6).

Regarding **claim(s) 3**, Hanson, in the same field of endeavor, teaches, wherein said sending said first instant message to said address occurs only after determining that said recipient is available to receive an instant message (FIGS. 7-9 and column 8,

lines 57-63) [The ACP 125 queries the database to determine if the user is currently on line to send the voice mail as an instant message].

8. **Claim(s) 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk in view of Ward as applied to **claim(s) 1** above, and further in view of Agraharam et al. (US 6,654,448 B1).

Regarding **claim(s) 7**, Adamczyk in combination with Ward as applied to **claim(s) 1** above differs from **claim(s) 7**, in that it fails to disclose sending data indicative of said first voice mail message's length of time.

However, Agraharam, in the same field of endeavor, teaches a method, further comprising: sending data indicative of said first voice mail message's length of time (FIG. 1 and column 6, lines 23-36) [The information is data that indicates the time required for transmitting the message].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk in combination with Bijl using the network as taught by Agraharam.

This modification of the invention enables the system to send data indicative of said first voice mail message's length of time so that the system would charge the user for each message transmitted (Agraharam: column 6, lines 37-44).

Regarding **claim(s) 8**, Agraharam, in the same field of endeavor, teaches a method, further comprising: sending data indicative of a number of voice mail messages associated with said recipient (FIG. 1 and column 5, lines 23-36) [The information is data that indicates the cumulative number of documents transmitted].

9. **Claim(s) 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk in view of Ward as applied to **claim(s) 1** above, and further in view of Groner (US 6,507,643 B1).

Regarding **claim(s) 9**, Adamczyk in combination with Ward as applied to **claim(s) 1** above differs from **claim(s) 9**, in that it fails to disclose converting said first voice mail message to an email message, determining an email address associated with said recipient and sending said email message to said email address.

However, Groner, in the same field of endeavor, teaches a method, further comprising: converting said first voice mail message to an email message (FIG. 2 and column 4, line 65 to column 5 line 1) [The voice-to-electronic mail system 30 generates a text message file from the audio message from the caller, thereby converting the voice mail message to an email message];

determining an email address associated with said recipient (FIG. 2 and column 4, lines 62-65) [The voice-to-electronic mail system 30 determines an e-mail address in accordance with the recipient's telephone number]; and

sending said email message to said email address (FIG. 2 and column 5, lines 2-4) [The voice-to-electronic mail system 30 sends a text message file at the recipient's e-mail address].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk in combination with Bijl using the voice-to-electronic mail system as taught by Groner.

This modification of the invention enables the system to convert said first voice mail message to an email message, determining an email address associated with said recipient and sending said email message to said email address so that the system would reduce the amount of data that is transmitted (Groner: column 3, lines 41-43).

### ***Response to Arguments***

10. Applicant's arguments with respect to **claim(s) 1-15, 17 and 18** have been considered but are moot in view of the new ground(s) of rejection.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Gerald Gauthier  
Primary Examiner  
Art Unit 2614

GG  
March 15, 2007